

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Frederick L. Ross
U.S. Patent Serial No.: 09/865,470
Filing Date: May 24, 2001
Group No.: 3627
Examiner: Maria Teresa T. Thein
Confirmation No. 2938
Title: LOCAL RETURNS OF REMOTELY PURCHASED
MERCHANDISE WITH RETURN CODE VALIDATION

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

REPLY BRIEF

Pursuant to 37 C.F.R. § 1.193, Appellant respectfully files this Reply Brief in response to the Examiner's Answer dated January 29, 2008.

ARGUMENTS

Appellant filed an Appeal Brief on November 2, 2007, explaining clearly and in detail why Claims 1-39 are allowable over the prior art cited by the Examiner in the Final Office Action mailed February 3, 2006. Specifically, Appellant demonstrated that the rejection of Claims 1-39 over the proposed *Junger-Hauser* combination is improper. For the reasons discussed below, Appellant respectfully submits that these rejections continue to be improper and should be reversed by the Board.

I. Appellant's Claims are Allowable over the Cited References

Appellants have carefully reviewed the Examiner's Answer delivered on January 29, 2008. However, Appellant continues to submit that *Junger* and *Hauser*, even when considered in combination, do not disclose, teach, or suggest the combination of elements recited in Appellant's claims.

A. Claims 1, 11, and 21

In the Appeal Brief, Appellants demonstrated that the proposed *Junger-Hauser* combination does not disclose, teach, or suggest “*validating the return by matching the return validation code with a pre-authorization code provided by the consumer to the local returns site,*” as recited in Appellant's Claim 1. Specifically, Appellant showed that *Junger*, as relied upon by the Examiner, merely discloses a method for obtaining return authorization for a batch of items. (*Appellant's Appeal Brief*, pages 21-24). Additionally, Appellant showed that although *Junger* discloses identifying a product by product number (i.e., SKU) and/or identifying a customer by customer reference number *Junger* does not disclose “a return validation code” or the operation of “matching the return validation code with a pre-authorization code,” as recited in Claim 1.

In the *Examiner's Answer*, the Examiner continues to cite Column 2, lines 41-56 of *Junger* as disclosing Appellant's step of “*validating the return by matching the return validation code with a pre-authorization code provided by the consumer to the local returns site,*” as recited in Appellant's Claim 1. (*Examiner's Answer*, pages 15-16). However, the cited sections merely disclose using “identifying information for a product” to determine if the returned product “satisfies applicable return criteria” and then generating a return authorization number for a batch of items including the product. (Column 2, lines 41-56). It

continues to be Appellant's contention that the product identifying information disclosed in *Junger* is not analogous to Appellant's "return validation code" and is not used in a manner that results in it being matched "with a pre-authorization code provided by the consumer to the local returns site," as recited in Claim 1.

Rather, "the identifying information" referred to in the passages cited by the Examiner is disclosed in *Junger* as including a barcoded SKU. The barcoded SKU identifies the **product** rather than a **return authorization**. (Column 4, lines 55-56). For example, *Junger* discloses a bar code scanner "for scanning barcoded SKU and, possibly, serial numbers for returned products." (Column 4, lines 55-56). According to *Junger*, the scanned SKU is provided to the manufacturer who "receives UPC and serial number information for return validation . . . [and] checks the electronic registration database to ensure that the identified product meets product return criteria." (Column 6, lines 58-64). Thus, the scanned SKU is used to identify the product so that a return authorization number can be generated. There is no disclosure that the scanned SKU is matched with a "pre-authorization code" to validate the return, as recited in Appellant's Claim 1. Accordingly, Appellant continues to maintain that the barcoded SKU or other product identifying information is not analogous to a return validation code.

The Examiner also states in the *Examiner's Answer* identifies the "entering the name and phone number and a customer reference number for return authorization approval" as being "verified and re-validated" and, thus, analogous to "*matching the return validation code with a pre-authorization code provided by the consumer to the local returns site*," as recited in Appellant's Claim 1. (*Examiner's Answer*, page 16). It continues to be Appellant's contention, however, that the customer reference numeral disclosed in *Junger* is not analogous to Appellant's "return validation code" and is not used in a manner that results in it being matched "with a pre-authorization code provided by the consumer to the local returns site.

Rather, *Junger* merely discloses that the customer reference number may be entered "if desired." (Column 7, lines 53-59). There is no indication in *Junger* that a return is validated by matching the customer reference number with the RMA number or anything else. In fact, it continues to be Appellant's contention that *Junger* does not disclose any operational use of the customer reference number at all. Since *Junger* indicates that such a feature is optional, the customer reference number cannot be used to validate a return authorization or generate a

return authorization number. Certainly, there is no indication in *Junger* that a return is validated by matching the customer reference number with the RMA number or anything else.

For further evidence that the customer reference number is not analogous to either of Appellant's "return validation code" or "pre-authorization code," Appellant directs the Board's attention to Figure 4H, which indicates that batch number 15 has been approved. The customer reference number associated with batch number 15 is "kb12444" and the RA Number is "915." These two numbers can not be matched to validate the return, and yet Figure 14H indicates that batch number 15 has been approved. In fact, *Junger* does not disclose any operational use of the customer reference number at all. *Junger* merely discloses that the customer reference number may be entered "if desired." (Column 7, lines 53-59). Such language indicates that such a feature is optional and is not used to validate a return authorization. This is further bolstered by Figure 4H of *Junger*, which shows the customer reference included in only two of the four entries. Accordingly, *Junger* does not disclose, teach, or suggest "validating the return by matching the return validation code with a pre-authorization code provided by the consumer to the local returns site . . . ," as recited in Appellant's Claim 1.

Hauser also does not disclose the operational step of "validating the return by matching the return validation code with a pre-authorization code provided by the consumer to the local returns site," as recited in Claim 1. Rather, *Hauser* merely discloses that "a return authorization shipping label" is provided to customers and then is used to "[identify] the merchant and the customer." (*Hauser*, Abstract). According to *Hauser*, the scannable bar code is scanned so that merchandise can be sorted by merchant." (*Hauser*, Abstract). There is no disclosure, however, of "validating the return by matching the return validation code with a pre-authorization code provided by the consumer to the local returns site," as recited in Claim 1.

For at least these reasons, Appellants contend that the proposed *Junger-Hauser* combination does not disclose, teach, or suggest "validating the return by matching the return validation code with a pre-authorization code provided by the consumer to the local returns site," as recited in Appellant's Claim 1. For analogous reasons, the proposed *Junger-Hauser* combination does not disclose, teach, or suggest similar claim elements recited in independent Claims 11 and 21. Accordingly, Appellants respectfully submit that the rejections of independent Claims 1, 11, and 21 and their respective dependent claims (including Claims 12-20 and 22-28) are improper and should be reversed by the Board.

B. Claim 29

In the Appeal Brief, Appellants demonstrated that the proposed *Junger-Hauser* combination does not disclose, teach, or suggest “*identifying the item of merchandise to be returned by the consumer to provide the retailer with advance notification of the return,*” as recited in Claim 29. Specifically, Appellant showed that *Hauser*, as relied upon by the Examiner, actually teaches away from Appellant’s recited claim elements since *Hauser* discloses that the merchant is advised of the return only after the merchandise is received at the central returns facility and it is scanned. (*Appellant’s Appeal Brief*, pages 27-28).

In the *Examiner’s Answer*, the Examiner again points to Column 7, line 67 through Column 8, line 5 of *Hauser* as teaching “a merchant electing to pre-authorize customers to return any purchased merchandise with which the customer are dissatisfied, without the need to obtain further authorization of the return.” (*Examiner’s Answer*, pages 18-19). The Examiner further states that “[s]uch a merchant electing to pre-authorize customers to return any purchased merchandise are considered the identifying the item of merchandise to be returned by the consumer to provide the retailer with advance notification of the return.” (*Examiner’s Answer*, pages 18-19). Thus, the Examiner has merely reproduced word-for-word the rejection in the Final Office Action rather than answer Appellant’s arguments made in the Appeal Brief.

It continues to be Appellant’s position that the cited portions of *Hauser* amount to an acknowledgement that *Hauser* does not disclose, teach, or suggest Appellant’s step of “sending a second communication to the retailer identifying the item of merchandise to be returned by the consumer to provide the retailer with advance notification of the return.” By the Examiner’s own admission, such steps are unnecessary in the system of *Hauser* since there is no “need to obtain further authorization of the return.” By contrast, Appellant’s claim language expressly requires “send[ing] a second communication to the retailer **identifying the item of merchandise to be returned by the consumer to provide the retailer with advance notification of the return.**” Because the cited portions of *Hauser* disclose that authorization is not required and that “the appropriate merchant . . . [is] advised” of the return only “after the merchandise is received” (Abstract; Column 7, line 63 through Column 8, line 5), Appellant respectfully submits that *Hauser* and the proposed *Junger-Hauser* combination, as relied upon by the Examiner, fails to disclose, teach, or suggest “*identifying the item of merchandise to be*

returned by the consumer to provide the retailer with advance notification of the return,” as recited in Appellant’s Claim 29.

For at least these reasons, Appellant contends that Claim 29 is allowable over the proposed *Junger-Hauser* combination. Accordingly, Appellant respectfully submits that the rejections of independent Claim 29 and Claims 30-39 that depend on Claim 29 are improper and should be reversed by the Board.

C. Claims 5, 6, 15, and 16

In the Appeal Brief, Appellant demonstrated that dependent Claims 5, 6, 15, and 16 recite elements that are distinguishable from the proposed *Junger-Hauser* combination. For example, Appellant contends that the proposed *Junger-Hauser* combination does not disclose, teach, or suggest “*receiving a third communication at the returns manager system, the third communication comprising a request for general returns information from the consumer*” and “*providing a fourth communication from the returns manager system to the consumer, the fourth communication comprising data representing general returns information,*” as recited in Claims 5 and 15.

In the *Examiner’s Answer*, the Examiner again relies on Column 2, lines 18-26 of *Junger* for disclosure of the recited features and operations. Specifically, the Examiner states:

Junger discloses a customer returning a product with no receipt or a receipt that does not have a correct serial number, a search is conducted in the local database for sale information concerning the specific item being returned. Junger discloses that if no sale information is located, the general database may be accessed and searched for sales information, and the return is handled accordingly. (Col. 2, lines 18-26).

(*Examiner’s Answer*, page 19). Appellant disagrees with this characterization of *Junger*. *Junger* actually discloses that, in response to a customer bringing the product into the retail establishment for return without a receipt, “**the retailer** may search the local database for sale information for sale information.” Thus, because the return transaction is handled by the retailer, Appellant respectfully contends that *Junger* does not disclose, teach, or suggest “receiving a third communication at the returns manager system, the third communication comprising a request for general returns information **from the consumer**,” as recited in Claims 5 and 15. Likewise, *Junger* does not disclose, teach, or suggest “providing a fourth

communication from the returns manager system to the consumer, the fourth communication comprising data representing general returns information,” as recited in Claims 5 and 15. Appellant submits that no communications are received from or transmitted to the consumer of the *Junger* system.

For at least these reasons, Appellant contends that the rejections of Claims 5 and 15 are improper and should be reversed by the Board. Appellant respectfully requests favorable action with respect to Claims 5 and 15, together with Claims 6 and 16 that depend from Claim 5 and 15.

II. The Proposed Combination of *Junger* and *Hauser* is Improper

In the Appeal Brief, Appellant demonstrated the proposed combination of *Junger* and *Hauser* is improper since one of ordinary skill in the art at the time of Appellant’s invention would not have been motivated to make the proposed combination. In the *Examiner’s Answer*, the Examiner states that the motivation for the proposed combination “is found in *Hauser* in col. 2, lines 5-6,” which states that “a centralized agency will be able to more efficiently process returned merchandise than could any individual merchant.” (*Hauser*, Column 2, lines 5-6). Appellant disagrees, however, with the Examiner’s conclusion that the cited portion of *Hauser* provides the requisite suggestion and motivation necessary to combine the references in the manner proposed by the Examiner.

Specifically, the Examiner’s findings ignore the fact that the objectives of the respective systems of *Junger* and *Hauser* are contrary to one another. The Federal Circuit has stated that “[i]t is essential to view the invention as a whole, taking each element into account as well as the advantages, properties, utilities, and results of the invention. *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987). The very principle and purpose of the system disclosed in *Junger* is the provision of a return system between two intermediary sources of a product. Each step of *Junger* relates to the return of merchandise between a retailer and a manufacturer. More specifically, *Junger* provides a system and method for obtaining batch reimbursement from a manufacturer for a retailer who has previously credited customers for the return of like items. With respect to the customer, *Junger* only discloses that a return is accepted “[w]hen a customer returns a product with a receipt,” “the serial numbers match,” and “all other return conditions are met.” (Column 2, lines 14-18). However, *Junger* assumes that this transaction

occurs prior to the receipt of the returned items for processing using the return system of *Junger*.

In contrast, the system disclosed in *Hauser* provides customers of merchants “with a return authorization shipping label” that can then be used to return merchandise to a “central return facility.” (Abstract). According to *Hauser*, “a return label is provided to the customer for inclusion with the merchandise being returned.” (Column 2, lines 16-19). The customer then “ships the merchandise being returned to the return facility.” Thus, while the objective of *Junger* is to provide for the processing of retailer returns on a batch-basis in a retailer-manufacturer context, the objective of *Hauser* is to provide for the processing of customer returns on an item-basis in a retailer-customer context. As a result, the solution proposed in *Junger* is drastically different from the solution proposed in *Hauser*, and one of ordinary skill in the art at the time of invention would not have been motivated to combine the disclosure of *Junger* with the disclosure of *Hauser*. Merchants seeking reimbursement for returns from a manufacturer have entirely different goals and are faced with entirely different obstacles than a customer returning an item to a retailer.

Because one of ordinary skill in the art would have found the references to be non-analogous, Appellant continues to submit that the proposed combination is improper. Further, Appellant continues to submit that the Examiner has used impermissible hindsight to arrive at an obviousness rejection. The inconsistencies in *Junger* and *Hauser*, as identified by Appellant above, evidences the Examiners reconstruction of Appellant’s claims by using hindsight to piece together disjointed portions of analogous, but inconsistent references.

For at least these reasons, Appellant respectfully submits that the proposed *Junger-Hauser* combination is improper. Accordingly, the rejection of Appellant’s claims over the proposed *Junger-Hauser* combination should be withdrawn.

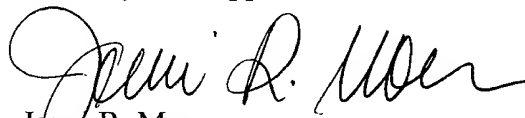
CONCLUSION

Appellant has demonstrated that the present invention, as claimed, is clearly distinguishable over the prior art cited by the Examiner. Therefore, Appellant respectfully requests the Board to reverse the final rejections and instruct the Examiner to issue a Notice of Allowance with respect to all pending claims.

No fees are believed due; however, the Commissioner is authorized to charge any fees or credits to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

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Attorneys for Appellant

A handwritten signature in black ink, appearing to read "Jenni R. Moen", written in a cursive style.

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Dated: March 27, 2008

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